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In re Application of
BURKE, et al.
Application No.: 10/517,717
Filing Date: 10 December 2004
Attorney Docket No.: 231461
For: SH2 DOMAIN BINDING INHIBITORS

DECISION ON REQUEST

UNDER 37 CFR 1.497(d)

This decision is in response to applicant's "Request to Correct Inventorship Under 37 C.F.R. § 1.48" filed 10 December 2004 in the United States Patent and Trademark Office (USPTO). The petition is being treated as a request under 37 CFR 1.497(d).

BACKGROUND

On 26 June 2003, applicant filed international application PCT/US03/19987, which claimed priority of an earlier application filed 28 June 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 28 December 2004.

On 10 December 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); the present petition which is being treated as a request under 37 CFR 1.497(d); an application data sheet and a First Preliminary Amendment.

On 26 January 2005, applicant filed a combined declaration and power of attorney and supplemental application data sheet. In addition, applicant provided payment of the appropriate surcharge for filing an executed oath or declaration later than thirty months from the priority date.

DISCUSSION

37 CFR 1.497(d) [formally, 37 CFR 1.48] states in part: "If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application....applicant must submit:

- (1) a petition including a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.63;

- (3) the fee set forth in 37 CFR 1.17(i); and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

Applicant has satisfied items (2) and (3).

Regarding Item (1), applicant has not submitted a statement from inventor Voigt avowing that the error in inventorship occurred without any deceptive intention on the inventor's part.

As to Item (4), applicant has not provided a statement granting the consent of the assignee. Assignee is required to establish its ownership in accordance with 37 CFR 3.73 (See MPEP 201.03 and 324).

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons above, applicant's request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

Applicant is hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file any request for reconsideration. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.497(d)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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